

## **REMARKS**

In the final Office Action, the Examiner rejected claims 1, 2, 7, 11, 12, 14-22, and 25-30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,135,809 ("Asakawa"), and rejected claims 3, 4, 9, 10, 13, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Asakawa in view of U.S. Patent No. 6,231,360 ("Horie"). By this amendment, Applicants propose to amend claims 1-2, 4-6, 8-12, 14-16, 18-20, 21-22, 24-25, and 28-30. Claims 1-30 remain pending in the application.

Applicants propose to amend claims 1, 11, and 21 to recite a card connector comprising "first and second side walls;" "a pair of guide grooves formed in said first and second side walls;" "a first space defined by said pair of guide grooves;" and "a second space defined by said first and second side walls." The specification, for example, provides support for the "first and second side walls" and "a pair of guide grooves formed in said first and second side walls" at page 14, lines 14-17. The claimed "first space" finds support, for example, in the specification at page 14, lines 18-24, describing "guide grooves ... formed ... so that their opened portions face each other," and the "second space" finds support, for example, at page 15, lines 9-10, which states that "[b]etween the two parallel second side walls 60 there is formed a space 61." As illustrated in Fig. 1, for example, "parallel second side walls 60" may correspond to the claimed "first and second side walls." Moreover, Figs. 2, and 4, for example, provide further exemplary support for these proposed claim amendments.

Applicants further propose to amend claims 2, 4-6, 8-9, 10, 12, 14-16, 18-20, 22, 24-25, and 28-30 to maintain proper antecedent basis.

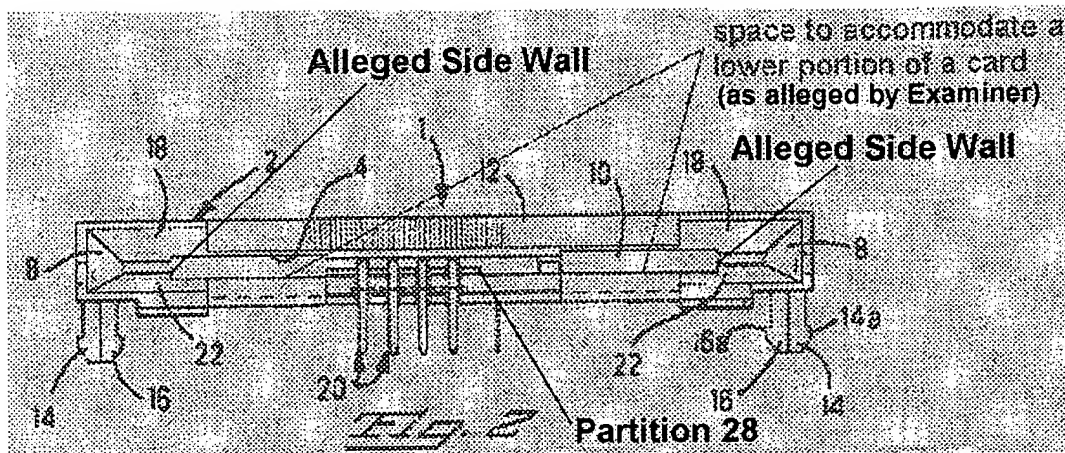
Applicants respectfully traverse the Examiners rejection of claims 1, 2, 7, 11, 12, 14-22, and 25-30 as being anticipated by Asakawa. Asakawa fails to disclose a card

connector comprising “a first space defined by said pair of guide grooves” and “a second space defined by said first and second side walls ...wherein ... said second space is configured to accommodate the lower body portion of said first card,” as recited in proposed amended claims 1 and 11.

Claim 11 further recites “an elastic braking piece arranged at such a position that the elastic braking piece engages the bottom surfaces of the upper body portion of the first card when the first card is inserted and engages the bottom surface of the card body portion of the second card when the second card is inserted.” Asakawa fails to disclose this feature of claim 11.

Proposed amended claim 21 recites “a first space defined by said pair of guide grooves; a second space defined by said first and second side walls, wherein the first and second space are configured to receive a first card.” Applicants submit that Asakawa also fails to teach at least these features of proposed amended claim 21.

In the final Office Action, the Examiner argued that “[t]he connector of Asakawa can receive a card with a lower body portion that extends on either side of partition 28.” (Final Office Action, page 4.) Proposed amended claims 1, 11, and 21, however, each recite “a second space *defined by* said first and second side walls.” (Emphasis added.) Fig. 2 of Asakawa, as modified by the Examiner and Applicants (below), illustrates that the alleged spaces on which the Examiner relies sit between partition 28 and either one of the alleged side walls of housing 2, and are thus not “defined by said first and second side walls.” Thus, the spaces on which the Examiner relies do not correspond to a “second space,” as recited in proposed amended claims 1, 11, and 21.



Moreover, Applicants again submit that the space on which the Examiner relies is not “configured to accommodate the lower body portion of said first card,” as claims 1 and 11 require. (See Reply dated October 6, 2004, at pages 12-13.) Claims 1 and 11 recite a “first card having an upper body portion, a lower body portion formed narrower than the upper body portion ... and stepped portions formed *along both side edges of the card* by a bottom surface of said upper body portion and a bottom surface of said lower body portion.” (Emphasis added.) The Examiner argues that the “connector of Askawa can receive a card with a lower body portion that extends on *either* side of partition 28.” (Final Office Action, page 4. (Emphasis added.) Any card that would fit “on *either* side of partition 28,” however, would not have “stepped portions formed along *both side edges of the card*,” as recited in claims 1 and 11.

As to amended claim 21, Asakawa fails to teach that “the first and second space are configured to receive a first card, said first card having ... stepped portions formed along *both side edges of the card* by a bottom surface of said upper body portion and a bottom surface of said lower body portion.” (Emphasis added.) The Examiner points to “at least one of the spaces shown in [Fig. 2 of Asakawa],” as corresponding to the claimed first and second spaces. For at least the reasons explained above, however,

the alleged “spaces” in Fig. 2 of Asakawa cannot accommodate a first card having “stepped portions formed along both side edges of the card by a bottom surface of said upper body portion and a bottom surface of said lower body portion,” as claim 21 requires.

Further, Applicants respectfully disagree with the Examiner’s argument that a “recitation that an element is ‘configured to’ perform a function is not a positive limitation but only requires the ability to so perform” and “does not constitute a limitation in any patentable sense.” (Final Office Action, page 6.) To configure means, “to design, arrange, set up, or shape with a view to specific applications or uses.” (American Heritage College Dictionary, 3d Ed., 1997, copy attached.) Proposed amended claims 1 and 11 recite that spaces “configured to accommodate the lower body portion of said first card” and define a structure of the first card. Consequently, Applicants submit that in the present patent application, the recitation of the configuration of the second space constitutes a structural claim element, which should receive patentable weight. Proposed amended claim 21 recites that “the first and second space *are configured to* receive a first card” (Emphasis added), which also constitutes a structural claim element and should also receive patentable weight for reasons discussed above.

Moreover, Applicants submit that even if Asakawa could be construed as describing all elements recited in claims 1, 11, and 21 (and Applicants dispute that it does), Asakawa does not constitute “an enabling description of the desired subject matter.” (See MPEP §2121.01.) Asakawa does not describe first and second cards, a space “configured to accommodate the lower body portion of said first card,” as recited in claims 1 and 11, or a first and second space that “are configured to receive a first

card,” as recited in claim 21. Fig. 2 of Asakawa, upon which the Examiner relies for teaching the spaces recited in claims 1, 11, and 21, does not “show all of the claimed structural features and how they are put together,” as required by MPEP §2121.04.

In addition, Claim 11 further recites “an elastic braking piece arranged at such a position that the elastic braking piece *engages the bottom surface* of the upper body portion of the first card... and *engages the bottom surface* of the card body portion of the second card.” The Examiner contends that because “Asakawa discloses the contacts 20 and 50 contacting the terminals of the card C, C”), which are on the bottom surface of the body portion,” such contacts correspond to the elastic braking piece recited in claim 11. (Final Office Action, at page 5.) Applicants respectfully disagree, noting that an elastic braking piece that contacts “the terminals of the card” differs from one that “engages the bottom surface of the card,” as recited in claim 11. Applicants further note that each of claims 7 and 27 recites “an elastic braking piece arranged at such a position that the elastic braking piece engages the bottom surface of the upper body portion of the first card... and engages the bottom surface of the card body portion of the second card,” and that Asakawa fails to disclose this feature for each of these claims, as well.

In light of the above-described deficiencies of Asakawa, claims 1, 11, and 21 are allowable over the applied reference. Furthermore, claims 2 and 7 are allowable at least due to their dependence from claim 1; claims 12, 14-20 are allowable at least due to their dependence from claim 11; and claims 22 and 25-30 are allowable at least due to their dependence from claim 21.

Applicants respectfully traverse the Examiner's rejection of claims 3, 4, 9, 10, 13, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Asakawa in view of Horie. As noted above, Asakawa fails to disclose a card connector comprising "a first space defined by said pair of guide grooves" and "a second space defined by said first and second side walls ...wherein ... said second space is configured to accommodate the lower body portion of said first card," as recited in proposed amended claims 1 and 11. Claim 11 further recites "an elastic braking piece arranged at such a position that the elastic braking piece engages the bottom surfaces of the upper body portion of the first card when the first card is inserted and engages the bottom surface of the card body portion of the second card when the second card is inserted." Asakawa also fails to disclose this feature of proposed amended claim 11. Moreover, as discussed above, Asakawa fails to teach "a first space defined by said pair of guide grooves; a second space defined by said first and second side walls, wherein the first and second space are configured to receive a first card," as recited in proposed amended claim 21.

Horie does not cure these deficiencies of Asakawa. Indeed, Horie does not disclose "a first space defined by said pair of guide grooves" and "a second space defined by said first and second side walls," as recited by proposed amended claims 1, 11, and 21. Rather, Horie discloses resinous frame 8, having a cut portion 21 along its first side and an ejecting shaft 3 at its second side. (See Horie at Fig. 2; Col. 4, lines 44-63.) As illustrated in Fig. 2 of Horie, cut portion 21 and the space for accommodating ejecting shaft 3 do not constitute a "pair of guide grooves" or define "a first space." Moreover, Horie certainly fails to teach or suggest a card connector, "wherein ... said second space is configured to accommodate the lower body portion of

said first card,” as recited in proposed amended claims 1 and 11, or “wherein the first and second space are configured to receive a first card,” as recited in proposed amended claim 21.

Horie also fails to teach or suggest “an elastic braking piece arranged at such a position that the elastic braking piece engages the bottom surfaces of the upper body portion of the first card when the first card is inserted and engages the bottom surface of the card body portion of the second card when the second card is inserted,” as further recited in proposed amended claim 11. As discussed above, Asakawa does not teach or discuss this claim element. Thus, Applicants submit that Asakawa and Horie, taken alone or together, fail to teach or suggest this claim element. Claims 3 and 23 also recite this claim element, and are therefore allowable over the purported combination of Asakawa and Horie for at least this reason.

Given the above noted deficiencies of both Asakawa and Horie, even if these references were combinable in the manner suggested by the Examiner, their combination would still fail to teach or suggest all elements of the claimed card connector, as recited in proposed amended claims 1, 11, and 21. Claims 3, 4, 9, 10, are thus allowable at least due to their dependence from claim 1; claim 13 is allowable at least due to its dependence from claim 11; and claims 23 and 24 are thus allowable at least due to their dependence from claim 21.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-30 in condition for allowance. Applicants submit that the proposed amendments of claims 1-2, 11-12, and 21-22 do not raise new issues or necessitate the undertaking of any additional search of the art by the

Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: February 10, 2005

By: \_\_\_\_\_

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